

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 39, 46 and 53-54 are amended without prejudice or disclaimer.

#### **Rejection of Claims 39-45 Under 35 U.S.C. §101**

The Office Action rejects claims 39-45 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Assignee has made appropriate amendments to claim 39 to require that at least one of the claimed steps is connected to another statutory category. Accordingly, claim 39 recites “executing via a processor the process for obtaining the performance content....” Accordingly, claim 29 and its dependent claims comply with 35 U.S.C. §101.

#### **Rejection of Claims 39-54 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 39-54 under 35 U.S.C. §103(a) as being unpatentable over Picco et al. (U.S. Patent No. 6,029,045) (“Picco et al.”) in view of Andros et al. (U.S. Patent No. 5,045,850) (“Andros et al.”) in further view of Godwin (U.S. Patent No. 6,741,834) (“Godwin”). Assignee traverses this rejection and provides minor amendments to distinguish from the art. These amendments are not made for patentability, however, and two arguments supporting patentability shall be set forth below. First, even if combined, the references fail to disclose each feature of the claims, and second, one of skill in the art would not likely, by a preponderance of the evidence, combine these references in the manner proposed.

Assignee addresses whether the cited art discloses each feature of claim 39. Claim 39 recites detecting a need for the video performance content by determining whether stored video performed content is out of date, wherein the stored video performance content is determined to be out of data based on a video performance content class of the stored video performance content. The Office Action on page 3 asserts that this feature is taught by Picco et al. in column

6, line 57 – column 7, line 2. However, this cited portion of Picco et al. states nothing with respect to determining whether the stored video performance content is out of data based on a video performance content class of the stored video performance content. This is conceded on page 4 of the Office Action and shall be addressed more fully below.

Claim 39 also recites, in its last step, determining whether the time-stamp of the stored video performance content matches the time of the latest update of the stored video performance content. Column 6, line 61 – column 7, line 12 of Picco et al. are cited as disclosing this claim feature. However, Picco et al. disclose a different function from what is recited in claim 39. Specifically, Picco et al. disclose that “each piece of a local content may also include the content profile as described below, a unique content identified code, a total time of the piece of local content, use statistics about the piece of local content,...a view interval, a time of data local content may be viewed, an expiration date of the local content or a maximum number of times a piece of local content may be viewed.” In this case, each of these pieces of information are part of “each piece of local content.” The difference between this disclosure and the “determining” step of claim 39 is that claim 39 recites two different times related pieces of information. The first is a time-stamp of the stored video performance content. Next, the step involves determining whether that time-stamp matches the time of the latest update of the stored video performance content. The time of the latest update of the stored video performance content is the second time element of claim 39. Therefore, because Picco et al. only refer to an expiration date of the local content or a time of day of the local content may be viewed, and states nothing with respect to a time of the latest update of stored performance content, Picco et al. fail to disclose this claim feature.

Furthermore, the time of day the local content may be viewed and the expiration date of the local content do not constitute a time-stamp of the stored video performance content. In

order to clarify this difference, claim 39 is amended to recite wherein the time-stamp of the stored video performance content is associated with a time the stored video performance content was stored. Therefore, this further distinguishes from the cited art since none of the time associated with each piece of local content are disclosed as being related to a time the stored previous video performance content was stored. Accordingly, this feature is not disclosed or suggested by Picco et al.

Next, the Office Action concedes that Picco et al. fail to disclose wherein the stored video performance content is determined to be out of date based on a video performance content class of the stored video performance content. The Office Action asserts that Andros et al. disclose this feature in column 12, line 64 – column 13, line 22. This analysis is respectfully traversed. The Office Action asserts that this portion of Andros et al. disclose that a user network may elect to receive updates for different types of content such as sports, weather and stocks at different times, wherein the content is updated at different frequencies according to its type and source. However, this portion of the reference discloses the following:

"Individual subscribers having identification codes stored by a plurality of local switches 12 in the network 10 specify at least one control parameter for generating pages which contain information from the page information source. For example, the page information source may be market information such as, but not limited to, stock quotation information obtained from a stock exchange, weather information, sport scores or any other source of information which is variable in time for which a subscriber to paging services in the network 200 desires to receiver [sic] pages containing updated information. For example, a subscriber could elect when subscribing to services provided by the page source 202 to have sports scores transmitted periodically for college or professional football games or other types of sports. Halftime and/or final scores could be transmitted for sports games. Updated weather reports could be transmitted to persons who desire to have updated weather information for purposes of travel or any other purpose in which actions are varied in response to weather information.'" (Emphasis added.)

The error in the analysis is that Andros et al. fail to disclose wherein the stored video performance is determined to be out of date based on a video performance content class of the

video performance content. In the Office Action characterization, it asserts that “the content is update at different frequencies according to its type and source.” This is incorrect. As can be seen by the highlighted portion quoted above from Andros et al., it is not a video performance content class that determines whether the stored video performance content is out of date, but rather a subscriber’s election. The various examples provided in the reference are various ways in which a subscriber can elect to receive updated information as desired. Column 12, line 64, states that “individual subscribers...specify at least one control parameter for generating pages....” Therefore, rather than teaching that stored video performance content is determined to be out of date based on a video performance content class, Andros et al. rather disclose that a subscriber can elect how “to receive pages containing updated information.” Therefore, Andros et al. fail to disclose this claim feature.

Another difference between Andros et al. and claim 39 is that Andros et al. clearly do not disclose that “stored video information content” is determined to be out of date based on a video performance content class of the stored video performance content. Andros et al. is a very old reference which refers to a paging network. Column 11, line 42, describes the type of information that is received in a page. Herein, they state “FIG. 6 illustrates a block diagram of a paging source 202 which may be utilized for generating numeric or alphanumeric pages for applications such as changing the display of an electronic sign 204.” Clearly, the use of paging devices was previously known and limited to simple messages that can be generated using numerical or alpha numeric pages. Claim 39 is amended to recite that the performance content is “video performance content” which clearly distinguishes from the paging disclosure of Andros et al. Furthermore, pages are not stored. There is no place in the cited portions of Andros et al. which suggests that the page information is stored and indeed it is commonly known that such information is not stored on a paging device in such a manner as that it can become out of date

according to the context of claim 39. Accordingly, due to the age of the Andros et al. reference and the specific context of paging information as opposed to video performance information, and furthermore because Andros et al. do not disclose or suggest stored video performance content, this particular feature of claim 39 with respect to the performance content class is not disclosed or suggested by Andros et al.

Next, the Office Action also cites Godwin as disclosing another feature recited in claim 39. Claim 39 recites transmitting a query to determine a time of a latest update of the stored video performance content, receiving the time of the latest update of the stored video performance content in response to the transmitting of the query and accessing a time-stamp of the stored video performance content. The Office Action refers to column 7, line 23 – column 9, line 10 of Godwin with respect to the time-stamp feature of the stored video performance content. The Office Action states that “determining the latest update of the content from a time tag of the content” is disclosed in Godwin. This analysis is traversed because the time tag that is found in column 8, lines 50-59 differs from the time-stamp of the stored video performance content recited in claim 39. Specifically, column 8 states “the latest error free data packets having EPG data describing the channels and media programs are received from either the satellite 108 or the repeater 112 and stored 802. In one embodiment, each of the data packets transmitted to the subscriber receiver 110 includes a time tag that is used to determine which of the received EPG data packets represent the latest information.” The error in the analysis is that the “EPG” information refers not to stored video performance content but to an electronic program guide (see column 2, lines 26-27 of Godwin).

Thus, Godwin is discussing updating the latest information of the electronic programming guide and not stored video performance content. Therefore, the data packets that include a time tag refer to time tags associated with the received electronic program guide data

packets that represent the latest information of the guide. Column 8 defines the EPG data not as stored video performance content but as “describing the channels and media programs [that] are received from either the satellite 108 or the repeater 112 and stored 802.” Therefore, since it is clear that the time tag disclosed by Godwin does not relate to stored video performance content but rather to electronic programming data that describes channels and media programs, it would be clear to one of skill in the art that Godwin fails to disclose this claim feature.

Therefore, numerous features of claim 39 have been discussed above with respect to there not being disclosed or suggested in the combination of art.

Additionally, one of skill in the art would not likely combine these references in the manner described. For example, the Office Action on pages 4 and 5 assert that:

“it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Picco et al. with Andros et al. and Godwin for the purpose of determining that stored data is old or out-of-date by comparing latest update time values and updating different types of content at different rate [sic]. Maintaining the date and time of content modifications are common techniques used in the art for effectively implementing updates, synchronizing data and keeping track of the current version of stored content in order to keep the stored content up-to-date. It is obvious that different types of network content have different expiration times and therefore require more or less frequent update checking depending on the kind of content. Furthermore, it would have been obvious to use a GPS in the system that identifies the location with a range of coordinates of a user in order for the system to provide content to the user that is related to and associated with the user’s global location.”

MPEP 2142 requires that an analysis supporting a rejection under §103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” While there is an articulated reason in the Office Action, it is not persuasive. For example, after citing Picco et al. with Andros et al. and Godwin, the remaining “purpose” on page 5 is essentially a commentary on what one of skill would generically do. In other words, there is no specific articulation of why Picco et al. should be modified or combined in any specific way with the disclosure of

Andros et al. and Godwin. For example, numerous specific issues immediately arise. Why would one of skill in the art, beginning with the disclosure of Picco et al. which relates to inserting local content into programming content look to or utilize the paging system of Andros et al.? Andros et al. disclose a specific distribution mechanism for pages, which as has been set forth above, are disclosed as “numeric or alphanumeric pages for applications such as changing the display of an electronic sign 204.” Column 11, lines 42-45. Andros et al. set forth also in column 4, numerous places, that the protocol that is used is a “modified X.25 protocol.” This is a particular protocol related to paging. Accordingly, would one of skill in the art, by a preponderance of the evidence, with an understanding of the disclosure of Picco et al. and its concept of delivering video programs to a set top box into the house of a user as is described in its abstract, look to the paging application of Andros et al.? The preponderance of the evidence is against one of skill in the art having such motivation to combine an older text-based technology of Andros et al. with a video content based disclosure of Picco et al. In any event, no specific analysis or articulated rational underpinning is provided in the Office Action with respect to the specific disclosure of Andros et al.

A similar problem exists with Godwin. There is no specific articulation of why one of skill in the art would modify the disclosure of Picco et al. with the disclosure of Godwin. Furthermore, our arguments set forth above explain how the Office Action’s interpretation of the specific teachings of Andros et al. and Godwin are not correct. Therefore, when page 5 of the Office Action states that one of skill in the art would combine these references “for the purposes of determining that stored data is older out-of-date by comparing latest update time values and updating different types of content at different rates.” It is difficult to find that specific disclosure from the cited art. Indeed, the reasoning with respect to why one of skill in the art would combine these references is primarily focused on the language of the claims and not the

specific disclosure or suggestion that can be gleaned from the prior art. In this respect, MPEP 2142 requires that “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” The analysis on page 5 of the Office Action leans too far toward essentially taking judicial notice of “common techniques used in the art”, rather than the specific portions of the references that are cited. To this extent, Assignee traverses the effective taking of official notice about what “common techniques used in the art” are and submits that essentially a *prima facie* case of obviousness has not been made with respect to the combination of these references. Accordingly, for these various reasons, the preponderance of the evidence is against one of skill in the art likely combining these references or having sufficient motivation to combine these references. Accordingly, for this additional reason, claim 39 is patentable and in condition for allowance.

(Assignee also notes, however, that we are not arguing that there is no suggestion or motivation to combine these references. In other words, our argument is that there is insufficient motivation by a preponderance of the evidence. Accordingly, one cannot respond to this line of reasoning by arguing that there some motivation or reason to combine. The reason to combine or motivation to combine, based on the preponderance of the evidence standard, must out weigh our arguments set forth above.)

Claims 40-45 and 53 each depend from claim 39 and recite further limitations therefrom. Accordingly, these claims are patentable and in condition for allowance as well.

Claim 46 is amended in a similar manner to claim 1. Accordingly, claim 46 and its dependent claims 47-52 are patentable and in condition for allowance.



**CONCLUSION**

Having addressed all rejections and objections, the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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